

***Remarks***

Reconsideration of this Application is respectfully requested.

Claims 19-23, 31, 32, and 35-39 are pending in the application, with claims 19, 31, and 35 being the independent claims. According to the Office Action dated April 20, 2005, claims 19-23, 31, and 32 are allowed, and claims 35-39 are rejected.

Based on the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding rejections and that they be withdrawn.

***Claim Rejections Under 35 U.S.C. § 102(e)***

Claims 35-39 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5,830,670 ("the '670 patent") and U.S. Patent No. 5,948,634 ("the '634 patent"), both to de la Monte *et al.* See Office Action, page 3. According to the Examiner:

De la Monte et al disclose SEQ ID NOS 5 and 6 which are antisense oligonucleotides that are complementary to nucleotides 831-859 and 850-877 of the instant SEQ ID NO: 1. It is noted that the patents also disclose antisense oligonucleotides of SEQ ID NOS: 1, 2, 3 and 4. It has been disclosed at columns 27-28 phosphorothioate linkages and pharmaceutical carriers with the antisense oligonucleotides.

*See id.* Applicants respectfully traverse this rejection.

### **1) The Cited Patents are not "By Another"**

Under 35 U.S.C. § 102(e)(2), a claim is anticipated if "the invention was described in . . . a patent granted on an application for patent *by another* filed in the United States before the invention by the applicant for patent . . ." *See id.* (emphasis added). Under § 102(e), "another" means a different inventive entity other than the Applicants. *See* MPEP § 2136.04; *see also In re Land*, 368 F.2d 866, 877, 151 USPQ 621, 631 (CCPA 1966). A claim cannot be rejected under § 102(e) based on a patent that has the same inventive entity. *See In re Costello*, 717 F.2d 1346, 1349, 219 USPQ 389, 391 (Fed. Cir. 1983).

The present application names Suzanne de la Monte and Jack R. Wands as inventors. The two cited patents also name Suzanne de la Monte and Jack R. Wands as inventors. Thus, the inventive entity of the cited patents is identical to the inventive entity of the present application. As noted by the CCPA, "[t]here appears to be no dispute as to the law that A is not 'another' as to A, B is not 'another' as to B, or even that *A & B are not 'another' as to A & B.*" *See In re Land*, 368 F.2d at 877, 151 USPQ at 631 (emphasis added); *see also* MPEP § 2136.04. Accordingly, the cited patents are not "by another" and are therefore not prior art under 35 U.S.C. § 102(e). Since the rejection under 35 U.S.C. § 102(e) was clearly in error, Applicants respectfully request that this rejection be reconsidered and withdrawn.

### **2) The Claims Do Not Read on the Cited Sequences**

In addition to the fact that the '670 and '634 patents are not prior art to the present application, Applicants also note that none of the cited sequences from the '670 and '634

patents (*i.e.*, SEQ ID NOs:1-6) are "complementary to an NTP mRNA sequence corresponding to a region within nucleotides 150-1139 of SEQ ID NO:1," as specified by claim 35.

Nucleotides 831-859 of SEQ ID NO:1 of the present application are:

CCTTGTGATCTGCCTGCCTCGGCCTCCCA.

Nucleotides 850-877 of SEQ ID NO:1 of the present application are:

CGGCCTCCCAAAGTGCTGGGATTACAGG.

Contrary to the Examiner's assertion, neither SEQ ID NO:5<sup>1</sup> nor SEQ ID NO:6<sup>2</sup> from the '670 and '634 patents are "complementary to nucleotides 831-859 and 850-877 of the instant SEQ ID NO:1." Thus, claims 35-39 do not read on the cited sequences from the '670 and '634 patents in any event.

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<sup>1</sup> ATCGCTTGAACCCGGGAGGCGGAGGTTGCG (*see* '670 patent, column 28, line 3; '634 patent, column 28, line 44)

<sup>2</sup> GGGGAGGCTGAGGCAGGAGAATCGCTTGAA (*see* '670 patent, column 28, lines 5-6; '634 patent, column 28, lines 46-47)

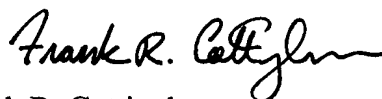
***Conclusion***

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider the presently outstanding rejection and that it be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Reply is respectfully requested.

Respectfully submitted,

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